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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,612	12/02/2005	Michihiro Izumi	03500.018183.	1506
5514	7590	09/14/2009	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800			MURRAY, DANIEL C	
ART UNIT	PAPER NUMBER			
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/559,612	IZUMI, MICHIIRO	
	Examiner	Art Unit	
	DANIEL C. MURRAY	2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 June 2009.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 34-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 34-42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26JUN2009 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 34-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chimura et al. (US Patent # US 6,400,719 B1)** in view of **Strauss et al. (US Patent # 5,940,598)** in view of

Mussman et al. (US Patent Publication # US 2004/0139209 A1) in further view of Nada (US 2002/0095516 A1).

a) Consider **claims 34, 37, and 40**, Chimura et al. clearly show and disclose, a communication apparatus, control method, and computer-readable medium including an Internet Protocol (IP) communication unit, transmit communication data to a communication partner station discriminated by a telephone number, and receive communication data from the communication partner station (figure 1, figure 7, abstract, column 2 lines 1-38), the apparatus, method, and computer readable medium comprising: a central processing unit (figure 2, column 4 lines 55-67); a memory unit coupled to the central processing unit (figure 2, column 4 lines 55-67); an IP address obtaining unit adapted to obtain an IP address of the communication partner station from a proxy server, based on a telephone number of the communication partner station (figure 1, figure 7, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34); a control unit adapted to establish a Voice over IP (VoIP) communication channel on an IP network according to the IP address of the communication partner station obtained by the IP address obtaining unit, and to transmit an image transmission request message prior to transmission of image data (figure 1, figure 7, abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 15-34, column 5 lines 45-67, column 6 lines 1-3); wherein, if the determination unit determines that transmission of communication data on the IP network based on a predetermined file transmission protocol can be performed, the control unit starts transmission of the image data between the communication apparatus and the communication partner station on the IP network based on a predetermined file transmission protocol using the obtained IP address of the communication partner station (abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34), and wherein, based on the image transmission permission message received from the communication partner station, in response to the image transmission request

message, in a case where reception of the communication data on the IP network based on a predetermined file reception protocol can be performed, the control unit starts reception of the image data between the communication apparatus and the communication partner station on the IP network based on the predetermined file reception protocol using the obtained IP address of the communication partner station (abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34). However, Chimura et al. does not specifically disclose a facsimile communication unit adapted to perform facsimile communication on a line switching network and an Internet Protocol (IP) communication unit, obtaining an IP address of the communication partner station through SIP (Session Initiation Protocol), a determination unit adapted to determine, based on contents of an image transmission permission message received from the communication partner station in response to the image transmission request message, whether transmission and reception of communication data can be performed on the IP network using a predetermined file transmission protocol, if the determination unit determines that transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel, and if the determination unit determines that reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel.

Strauss et al. show and disclose a universal or multipurpose network server having enhanced processing functions which are performed in association with a telecommunications network to provide multi-mode communications via a combination of the public switched telephone network

(PSTN) and a public packet data network, such as the Internet, wherein a facsimile communication unit adapted to perform facsimile communication on a line switching network and an Internet Protocol (IP) communication unit (figure 4, abstract, column 1 lines 57-61, column 7 lines 23-29 lines 40-53, column 8 lines 10-20).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate a facsimile communication unit adapted to communicate on a line switching network and IP network, as taught by, Strauss et al. into the system of Chimura et al. for the purpose of transmitting a facsimile signal (Strauss; column 7 lines 23-29). However, Chimura et al. as modified by Strauss et al. does not specifically disclose obtaining an IP address of the communication partner station through SIP (Session Initiation Protocol), a determination unit adapted to determine, based on contents of an image transmission permission message received from the communication partner station in response to the image transmission request message, whether transmission and reception of communication data can be performed on the IP network using a predetermined file transmission protocol, if the determination unit determines that transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel, and if the determination unit determines that reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel.

Mussman et al. show and disclose an apparatus which includes a device configured to support a first protocol for initiation, maintenance, and termination of a communication session

between call endpoints, and to support a second protocol for resolving endpoint addresses for the communication session wherein, obtaining an IP address of the communication partner station is accomplished by using SIP (Session Initiation Protocol)(abstract, paragraph [0003], [0013], [0014]).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate using SIP (Session Initiation Protocol), as taught by, Mussman et al. into the system of Chimura et al. as modified by Strauss et al. for the purpose of initiation, maintenance, and termination of a communication session (Mussman; abstract). However, Chimura et al. as modified by Strauss et al. as modified by Mussman et al. does not specifically disclose a determination unit adapted to determine, based on contents of an image transmission permission message received from the communication partner station in response to the image transmission request message, whether transmission and reception of communication data can be performed on the IP network using a predetermined file transmission protocol, if the determination unit determines that transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel, and if the determination unit determines that reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel.

Nada show and disclose an Internet telephone system and an Internet telephone apparatus using the Internet wherein an IP address obtaining means judges by analyzing the telephone number of the communication partner whether or not the communication with the communication partner station through a VoIP transmission path is possible wherein, a determination unit adapted to

determine, based on contents of an image transmission permission message received from the communication partner station in response to the image transmission request message, whether transmission and reception of communication data can be performed on the IP network using a predetermined file transmission protocol (abstract, [0028], [0039], [0047], [0052], [0058], [0064]), if the determination unit determines that transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel (abstract, paragraph [0028], [0052], [0058], [0064]), and if the determination unit determines reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel (abstract, paragraph [0028], [0052], [0058], [0064]).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate communicating using determining whether or not the communication through a VoIP transmission path is possible, as taught by, Nada into the system of Chimura et al. as modified by Strauss et al. as modified by Mussman et al. for the purpose of for the purpose of analog facsimile communication when communication on the IP network based on the predetermined file reception protocol cannot be performed (Nada; paragraph [0064]).

b) Consider **claims 35, 38, and 41, and as applied to claims 34, 37, and 40 above,** Chimura et al. as modified by Strauss et al. as modified by Mussman et al. as modified by Nada clearly show and disclose, the communication apparatus, control method, and computer-readable medium according to claim 34, 37, and 40, wherein the IP address obtaining unit judges whether a

communication can be performed with the communication partner station via the VoIP communication channel, by interpreting the telephone number of the communication partner station (Nada; abstract, paragraph [0028], [0052], [0058], [0064]), and wherein, if the communication cannot be performed with the communication partner station via the VoIP communication channel, the IP address obtaining unit calls the communication partner station on the line switching network and causes the facsimile communication unit to perform analog facsimile communication (Nada; abstract; paragraph [0028], [0052], [0058], [0064]).

c) Consider **claims 36, 39, and 42, and as applied to claims 34, 37, and 40 above,** Chimura et al. as modified by Strauss et al. as modified by Mussman et al. as modified by Nada clearly show and disclose, the communication apparatus, control method, and computer-readable medium according to claim 34, 37, and 40, wherein the IP address obtaining unit judges whether a communication can be performed with the communication partner station via the VoIP communication channel, by interpreting the telephone number of the communication partner station (Nada; abstract, paragraph [0028], [0052], [0058], [0064]), and wherein, if the communication can be performed with the communication partner station via the VoIP communication channel, the IP address obtaining unit tries to obtain the IP address of the communication partner station from the SIP proxy server (Chimura; abstract, column 2 lines 1-38, column 3 lines 66-67, column 4 lines 1-34, Mussman; (discloses using SIP to set up communications) paragraph [0003], [0013], [0014]).

Response to Arguments

5. Applicant's arguments filed 26JUN2009 have been fully considered but they are not persuasive.

Applicant argues that “[n]othing has been found in Nada that is believed to teach or suggest that the modem 1 selects a particular network or protocol for transmitting image data based on contents of a response to the request.

The Examiner respectfully disagrees; Nada clearly discloses that the modem 1 selects a particular network (IP Network/PSN(public switching network)) or protocol (IP/analog communication)for transmitting image data based on contents of a response to the request (abstract, [0028], [0039], [0047], [0052], [0058], [0064]). Nada clearly discloses that an attempt is made to determine whether the telephone at the receiving end is capable of making calls over an IP network by determining if the destination telephone number has a corresponding IP address and if it is determined that it does the call is made over the IP network. If it is determined that does is not (i.e. there is no IP address corresponding to the telephone number or if the response is not received within a predetermined time) the call is made through the PSN. Nada clearly discloses requesting an IP address corresponding to the telephone number of the destination telephone when an attempt is made to dial a destination phone number to establish communications (connection request). If the response contain information indicating (i.e. response contents) that the destination telephone number has a corresponding IP address then the IP network is selected (selecting a particular network) and if the response is that no corresponding IP address could be found or there was no response received in a predetermined time period the PSN is selected (selecting a particular network). Therefore, Nada clearly discloses selecting a network (IP/PSN) or protocol (IP/analog) based on the contents of the response to the connection request.

Applicant argues that “nothing has been found in Nada that is believed to teach or suggest that image data is transmitted and received by analog facsimile communications over a VoIP communication channel.”

The Examiner respectfully disagrees; Nada clearly discloses image data is transmitted and received by analog facsimile communications over a VoIP communication channel (abstract, [0003], [0028], [0034], [0035], [0047], [0052], [0058]). Nada clearly discloses and internet telephone system, to include facsimile machines as well as telephones, capable of transmitting over both an IP network and the PSN (public swathing network). Nada clearly discloses that an attempt is made to determine whether the telephone at the receiving end is capable of making calls over an IP network by determining if the destination telephone number has a corresponding IP address and if it is determined that it does the call is made over the IP network. If it is determined that does is not (i.e. there is no IP address corresponding to the telephone number or if the response is not received within a predetermined time) the call is made through the PSN. It is clear from the Nada that Voice data (i.e. telephone and fax data) is being transmitted via an IP network, VoIP.

Furthermore, VoIP is a generic term for the transmission of traditional telephone traffic (public switching network traffic)(i.e. telephone voice/fax data, where fax data is hard copy that has been scanned and converted for transmission over an analog phone line (Newton; page 374) over an IP network rather than a public switching network (Newton; page 979). Therefore while Nada may not use the term VoIP it is clear that what Nada discloses is clearly VoIP.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 6,542,472 B1
- US 2003/0133442 A1
- US 2002/0051146 A1
- US 2003/0160998 A1
- US 6,690,304 B1
- US 6,778,555 B1
- US 6,967,739 B2
- US 2007/018412 A1
- US 7,116,435 B2
- US 6,754,708 B1
- US 6,714,988 B2
- US 6,363,065 B1
- 5,517,324
- 5,946,634
- 6,147,774
- US 2002/0126317 A1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL C. MURRAY whose telephone number is 571-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571)-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/DCM/
Examiner, Art Unit 2443

/Tonia LM Dollinger/
Supervisory Patent Examiner, Art Unit 2443